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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/599,679

06/22/2000

Robert J. Brockway

TER0400.010

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02/02/2010

ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ZPS)

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EXAMINER

STORMER, RUSSELL D

ART UNIT

PAPER NUMBER

3617

NOTIFICATION DATE

DELIVERY MODE

02/02/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/599,679	<b>Applicant(s)</b> BROCKWAY, ROBERT J.	
	<b>Examiner</b> Russell D. Stormer	<b>Art Unit</b> 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25, and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 23, 25, 29 and 33 is/are allowed.
- 6) ☒ Claim(s) 13-22 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### ***Claim Objections***

In the amendment to claim 6, the addition to lines 9 and 10 creates potentially indefinite language because it can be interpreted to set forth at least two different limitations.

As best understood, the lines 8-10 of the claim appear to recite the circumferential barrier being disposed in an area of the rim which is absent any of the compactor wheel cleats.

However, it is believed that lines 8-10 can also be interpreted to recite that it is the circumferential barrier itself which is absent any of the cleats; or that the circumferential edge of the rim is absent any of the cleats.

Applicant should consider a further amendment to the claim, such as adding punctuation somewhere in lines 8-10 to clarify the intended language of the claim, or inserting a term such as - -and- -, or - -and being- -, or - -which is- -, or some other term which would positively recite which element is absent the cleats.

New claim 33 has language similar to the above noted language of claim 6 and should also be considered for an amendment.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 14, the newly added limitation that the outer circumferential edge of the barrier "is consistently perpendicular to the axle" lacks antecedent basis in the specification of the original patent and therefore introduces new matter into the disclosure.

This is a New Matter rejection.

### ***Reissue Applications***

Claims 13, 21, 22, 30, 31, and 32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered

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during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the amendment filed October 2, 2009, claims 13, 21, and 30 are broadened to exclude subject matter that was surrendered in the original application. Specifically, the limitation of the axle guard system including a “cleat-free area” which extends widthwise from the inner edge of the rim “at least about the width of one of said cleats” is not present in the claims.

Claim 13 continues to lack the limitation of the cleat-free area extending “at least about the width of one of said cleats” that was in the patented claims 1 and 13.

Claim 21 continues to lack the limitation of the cleat-free area extending “at least about the width of one of said cleats” that was in the patented claim 1.

Claim 30 continues to lack the limitation of the cleat-free area extending “at least about the width of one of said cleats” that was in the patented claim 1.

New claim 32 is similar to patented claim 1, but lacks the limitation of an axle guard system comprising a “cleat-free area” extending about the width of one of the cleats.

Claim 32 does add limitations of a plurality of cleats mounted to the face of the rim “in an orientation that is substantially parallel to the axle” that is not present in

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original claim 1, or any of the other patented claims. However, the last four lines of the claim recites an area free of the plurality of cleats formed around the rim, but does not positively recite a "cleat-free" area. This is considered to be an improper recapture of broadened claimed subject matter surrendered in the application because claim 32 recites an area free of the cleats having the specific orientation set forth in lines 6-8, but it does not recite an area that is absolutely free of cleats and does not preclude the presence of other types of cleats, or cleats arranged in a different orientation. So while claim 32 adds limitations that were not present in the patented claims, it is actually broader than claim 1 on which it is modeled (see lines 1-6 of page 15 of the Response filed October 2, 2009).

During prosecution of the original patent these limitations were added to claims 1 and 6 and argued as defining over the references of record. See the Remarks filed with the amendment of August 7, 1997 in which the "compaction cleats" and the "compaction wheel" are argued as not being disclosed by the references of record and that claims 1 and 14 have been amended to more clearly recite "these distinctions."

***Allowable Subject Matter***

Claims 1-12, 23, 25, 29, and 33 are allowable over the prior art of record.

### ***Response to Amendment***

The amendment filed October 2, 2009 is considered to overcome the recapture rejection of claims 23 and 25 because of the language added to these claims.

New claim 33 is considered to avoid a recapture rejection because it adds limitations not found in claim 6 after which it is modeled (see lines 7-14 of page 15 of the Response filed October 2, 2009). Claim 33 contains language similar to that the "orientation" language noted in claim 32 above, and further includes language similar to the "area free" of the specifically oriented cleats of claim 32, but claim 6 did not include any "cleat-free" limitations, and claim 33 does include the "circumferential barrier" language found in patented claim 6.

For this same reason, claim 6 as amended does not improperly recapture broadened claimed subject matter surrendered in the application.

### ***Response to Arguments***

Applicant's arguments filed October 2, 2009 have been fully considered but they are not persuasive.

In the arguments bridging pages 10 and 11 of the Response, Applicant notes that the Remarks filed August 7, 1997 during the prosecution of the 5769507 patent, Applicant state that "[n]one of the references of record disclose, teach, or suggest a compaction wheel having an axle guard system, as taught by the present specification." (emphasis added). On page 11 Applicant continues to stress that the limitation of an

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axle guard according to the specification was effectively argued and resulted in allowance of the patent.

Applicant then states that the previous office action “alleged that the axle guard system in this instance is defined by the last three lines of claim 1.”

While the quoted portions of the last office action appear to be accurate, it should first be noted that despite the arguments presented during prosecution of the patent with respect to “the limitation of an axle guard according to the specification,” claims are never allowed for what is disclosed in the specification. The claims in the patent were allowed because of what was recited *in the claims*, such as the structure of the axle guard as recited in the last three lines of claim 1.

Second, a finding of recapture is based in part on what was *claimed* in the patent, not what was disclosed in the specification.

On pages 11-13 of the Response, Applicant refers to MPEP 1412.02 and argues that the August 7, 1997 and December 16, 1997 Remarks “do not qualify as surrender of the limitations set forth in the last three lines of claim 1” and cites an example from the MPEP. Applicant then concludes that since the prosecution history shows that Applicant never argued that the cleat-free area extending widthwise “at least about the width of one of said cleats” was the limitation that rendered the claim allowable over the art of record.

While this appears to be correct in itself, the limitation of cleat-free area extending widthwise “at least about the width of one of said cleats” was included in the



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originally-filed version of claim 1, was a key limitation in defining that claim over the prior art. Therefore, that axle system which was argued to define over the references of record is the axle system as recited in claim 1, not any axle system which may have been disclosed in the specification.

On pages 12 and 13 Applicant cites several court decisions and states that the “axle guard system” arguments set forth in the prosecution of the patent are not clear and unmistakable statements that lead to one to believe that Applicant had disclaimed the axle guard system as specifically defined in the last three lines of claim 1.

The Examiner does not agree. The arguments in the prosecution of the patent regarding the “limitation of an axle guard according to the specification” is clearly directed to the axle guard as defined in the claims despite the erroneous statement arguing the specification. Even assuming *arguendo* that Applicant’s arguments should be interpreted literally, lines 16-21 of column 2 of the patent clearly describe the cleat-free area extending “at least about the width of one of the cleats.” Moreover, lines 13-59 of column 6 repeated describe the removal of one row of cleats, and refers to the axle guard system of figure 6 of the drawings which shows the cleat-free area 37 to be wider than the inner row of cleats 36 which have been removed.

It is submitted that the limitation of cleat-free area extending widthwise “at least about the width of one of said cleats” as recited in claim 1 was a key limitation in defining over the prior art of record.

Claim 1 was rejected in the first office action (May 7, 1997) under 35 USC 102(b) as anticipated by Shatto (US Patent 2336959). To overcome this rejection, claim 1 was amended to recite that the cleats were compaction cleats that were circumferentially spaced on, transversely spaced across and mounted to the face of the rim. The combination of the limitation of compaction cleats that are circumferentially spaced on, and transversely spaced across the rim and the limitation of the cleat-free area extending widthwise at least about the width of one of said cleats precluded the use of the Shatto patent, as well as the patents to Arenz (4227827), Takata (3650185), and Bertram et al (3853419) for instance. Takata and Bertram et al show circumferentially and transversely spaced cleats, but no cleat-free area; and Arenz shows circumferentially and transversely spaced cleats and a cleat-free area which is not clearly the width of about one of the cleats.

The finding of Recapture set forth above is consistent with the procedures outlined in MPEP 1412.02. Specifically, under the three-step test, (A) the Reissue application does include claims which are broadened; (B) the broadening does relate to surrendered subject matter; and (C) the claims were not materially narrowed in other respects.

With respect to (B) The Second Step, the first Sub-Step is applicable because the omitted or broadened limitations as set forth in the rejections above were relied upon by Applicant in the original patent application to make the claims allowable over the prior art. Please refer to the limitations of "at least the width of one of said cleats;"

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"adjacent to one side of said body;" "transversely space across;" and "compaction cleats," "compactor wheel," "circumferentially spaced on," and "mounted on" omitted from the claims as set forth in the rejection above.

With respect to first Second-Step of (B) The Second Step, these limitations were argued by Applicant without amendment and/or the claims were amended without a specific argument to those limitations.

With respect to (C) The Third Step, the Reissue application presents claims with omitted or broadened limitations; and the broadened claims do **not** include additional limitations that would materially narrow the claims in other respects, and thus do not avoid the recapture rule.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Russell D. Stormer/  
Primary Examiner, Art Unit 3617